

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor:	Dori Laskin	§
		§
		§
Conf. No.:	3359	§ Group Art Unit: 3695
		§
Appln. No.:	10/709,360	§ Examiner: Irene S. Kang
		§
Filing Date:	April 29, 2004	§ Attorney Docket No.: 160245-87US
		§

Title: METHOD AND APPARATUS FOR DETERMINING PERSONAL QUALIFIED DIVIDEND INCOME AND GENERATING INFORMATION STATEMENTS THEREOF

AMENDED APPEAL BRIEF (37 C.F.R. § 41.37)

This brief is being filed to correct a minor, non-substantive error that was recently discovered in the original Appeal Brief filed on February 27, 2009. Although no “Notification of Non-Compliant Appeal Brief” (the “Notification”) was received, Appellants are preemptively addressing the noted error. No extension of time fees are due. The fees required under § 41.20 were paid when the original Appeal Brief was filed and no additional appeal-related fees are believed to be due. However, if any fees are due, charge the fees to Deposit Account No. 50-1017.

Please replace pages 2-3 (both pages inadvertently numbered as page 2) and page 34 of the original Appeal Brief filed on February 27, 2009 with the following replacement pages 2A-2B and 34.

The following non-substantive changes were made in this amended Appeal Brief:

1. Page 34 now refers to **Section (X) Related proceedings Appendix**. The references to Sections X. APPENDIX OF RELATED DECISIONS and XI. OTHER MATERIAL THAT APPELLANT CONSIDERS NECESSARY OR DESIRABLE that appeared in the original Appeal Brief were deleted.

2. A revised Table of Contents is provided. The second page of the Table of Contents was amended to reflect the revised Section X and the deletion of the original Sections X and XI.

Pursuant to the instructions that normally appear on a Notification when an error in an Appeal Brief is communicated to an Appellant, only the amended sections are enclosed.

TABLE OF CONTENTS

I.	REAL PARTY IN INTEREST	4
II.	RELATED APPEALS AND INTERFERENCES.....	4
III.	STATUS OF CLAIMS.....	4
IV.	STATUS OF AMENDMENTS.....	4
V.	SUMMARY OF CLAIMED SUBJECT MATTER.....	4
VI.	GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	9
 PART 1: Claims 1-6, 8-14, 16-30, 32-37 and 39-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application Publication No. 2004/0078271 (Morano) in view of a newsletter from PriceWaterhouse Coopers (PWC)		
 PART 2: Claims 7, 15, 31 and 38 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Morano in view of PWC and further in view of U.S. Patent No. 7,016,873 (Peterson et al.)		
VII.	ARGUMENTS – REJECTIONS UNDER 35 U.S.C. § 103.....	10
 PART 1: Claims 1-6, 8-14, 16-30, 32-37 and 39-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Morano in view of PWC..... 10		
 1. There is a <u>clear error</u> in the Examiner’s Final Rejection of independent claims 1, 9, 17, 22, 25, 32, 39 and 43 because there is no proper motivation to modify Morano’s process in view of PWC to include a “QDI calculation engine...to automatically determine the personal QDI” (claims 1, 25); or to “automatically [determine] the personal QDI...using a QDI calculation engine” (claims 9, 17, 32, 39); or to “automatically [perform] a personal QDI calculation” (claims 22 and 43)		
 a. Background to Appellants’s claimed invention..... 10		
b. Morano..... 11		
c. PWC..... 11		
d. Examiner’s rejection of independent claims and rebuttal thereof..... 11		
e. Patentability of independent claims 1, 9, 17, 22, 25, 32, 39 and 43 over Moreno in view of PWC..... 13		

2. The Examiner's Final Rejection of independent claims 1, 9, 17, 22, 25, 32, 39 and 43 has an <u>omission of one or more essential elements needed for a prima facie rejection</u> , namely, a "QDI calculation engine...to automatically determine the personal QDI" (claims 1, 25); a step of "automatically determining the personal QDI...using a QDI calculation engine" (claims 9, 17, 32, 39); or a step of "automatically performing a personal QDI calculation" (claims 22 and 43).....	14
3. There is also <u>clear error</u> in the Examiner's Final Rejection of independent claims 22 and 43 because there is no proper motivation to modify Morano's process to include the feature in step (c) of "automatically comparing in the computer the personal QDI and the QDI on the Form 1099-DIV".....	14
4. The Examiner's Final Rejection of independent claims 22 and 43 has an <u>omission of one or more additional essential elements needed for a prima facie rejection</u> , namely, the feature in step (c) of "automatically comparing in the computer the personal QDI and the QDI on the Form 1099-DIV".....	15
5. Examiner's Final Rejection fails to rebut Appellants' arguments for patentability....	16
6. KSR vs. Teleflex holdings do not provide any basis for the Final Rejection.....	18
7. There is a clear error in the Examiner's Final Rejection of the dependent claims 2-6, 8, 10-14 and 16, 18-21, 23-24, 26-30, 33-37, 40-42 and 44.....	18
PART 2: Claims 7, 15, 31 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Morano in view of PWC and further in view of Peterson et al.....	18
PART 3: Conclusion.....	19
VIII. APPENDIX OF CLAIMS.....	20
IX. APPENDIX OF EVIDENCE.....	33
X. RELATED PROCEEDINGS APPENDIX.....	34

X. RELATED PROCEEDINGS APPENDIX

None.

Respectfully submitted,

DORI LASKIN et al.

March 16, 2009

(Date)

By:

Clark Jabolon

CLARK A. JABLON

Registration No. 35,039

PANITCH SCHWARZE BELISARIO & NADEL LLP

One Commerce Square

2005 Market Street - Suite 2200

Philadelphia, PA 19103

Telephone: (215) 965-1330

Direct Dial: (215) 965-1293

Facsimile: (215) 965-1331